



Attorney Docket No.: 28729U

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

IKESUE et al.

Serial No. 10/557,611

Examiner: WESTERBERG, N.

Filed: November 22, 2005

Group Art Unit: 4173

For: PREPARATION FOR EXTERNAL PERCUTANEOUS ADMINISTRATION  
CONTAINING NON-STEROIDAL ANTI-INFLAMMATORY DRUG AND  
INTERLEUKIN-1 ALPHA PRODUCTION INHIBITOR

RESPONSE TO RESTRICTION / ELECTION REQUIREMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the Official Action dated January 9, 2008. The one-month shortened statutory period for response is set to expire on February 9, 2008. Accordingly, this Response is timely filed within the time period set by the Examiner.

REMARKS

Claims 1-13 are pending in the captioned application. The Examiner has indicated that these claims are subject to restriction and/or election for the following reasons, in relevant part:

Group I: Claims 1-4 and 8-11, drawn to a transdermal formulation comprising a non-steroidal anti-inflammatory analgesic and an alkyl ester of

gallic acid and/or a phenolic radical scavenger having a branched-chain lower alkyl group.

Group II: Claims 5-7, drawn to compounds that are a phenolic radical scavenger having a branched-chain lower alkyl group and/or an alkyl ester of gallic acid.

Group III: Claim 12, drawn to a method of using an alkyl ester of gallic acid and/or a phenolic radical scavenger having a branched-chain lower alkyl group to inhibit the production of interleukin- $1\alpha$ .

Group IV: Claim 13, drawn to a method of using a non-steroidal anti-inflammatory analgesic and an alkyl ester of gallic acid and/or a phenolic radical scavenger having a branched-chain lower alkyl group to inhibit the production of interleukin- $1\alpha$ .

First Species Election Requirement: Regardless of the restriction group elected above, Applicant is required to elect one specific chemical compound as the inhibitor of interleukin- $1\alpha$  production.

Second Species Election Requirement: If restriction group I or IV is elected above, Applicant is required to elect one specific non-steroidal anti-inflammatory analgesic.

#### PROVISIONAL ELECTION

Applicants provisionally elect Group I, drawn to claims 1-4 and 8-11.

In response to the Examiner's requirement for applicants to elect one specific chemical compound as the inhibitor of interleukin- $1\alpha$  production, Applicants provisionally elect propyl

gallate.

In response to the Examiner's requirement for applicants to elect one specific non-steroidal anti-inflammatory analgesic, Applicants provisionally elect ketoprofen.

#### TRAVERSAL

Applicants respectfully traverse the Examiner's restriction / election requirement.

First, the Examiner has incorrectly asserted that claims 1-4 are drawn to a transdermal formulation comprising a non-steroidal anti-inflammatory analgesic and an alkyl ester of gallic acid and/or a phenolic radical scavenger having a branched-chain lower alkyl group. Applicants respectfully note that the transdermal formulation of claims 1-4 are drawn to an alkyl ester of gallic acid and a phenolic radical scavenger having a branched-chain lower alkyl group. Accordingly, Applicants provisionally elect propyl gallate and di-tert-butylhydroxytoluene as the alkyl ester of gallic acid and phenolic radical scavenger having a branched-chain lower alkyl group, respectively.

Secondly, the restriction / election requirement is traversed because it omits "an appropriate explanation" as to the existence of a "serious burden" if a restriction were not

required. See MPEP 803. A complete and thorough search for the subject matter set forth in the provisionally elected species set forth above would require searching the art areas appropriate to all other subject matter contained in this application. Since a search of the subject matter of the provisionally elected species and all other subject matter contained in this application would be coextensive, it would not be a serious burden upon the Examiner to conduct a search of all subject matter contained in this application.

Furthermore, applicants have paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring applicants to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing applicants to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not refundable.

#### CONCLUSION

In view of the foregoing, applicants respectfully request the Examiner to reconsider and withdraw the restriction /

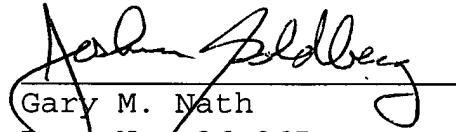
election requirement, and to examine all of the claims pending in this application.

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

**THE NATH LAW GROUP**

Date: February 7, 2008  
**THE NATH LAW GROUP**  
112 South West Street  
Alexandria, VA 22314  
Telephone: (703) 548-6284  
Facsimile: (703) 683-8396

  
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Gary M. Nath  
Reg. No. 26,965  
Joshua B. Goldberg  
Reg. No. 44,126  
Customer No. 34375

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